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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/636,081	08/06/2003	Pramod K. Gupta	24866A	9824
28624 7590 01/04/2010 WEYERHAEUSER COMPANY INTELLECTUAL PROPERTY DEPT., CH 1J27 P.O. BOX 9777 FEDERAL WAY, WA 98063				
EXAMINER PARA, ANNETTE H				
ART UNIT 1661		PAPER NUMBER		
NOTIFICATION DATE 01/04/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@weyerhaeuser.com

Office Action Summary

Application No.

10/636,081

Applicant(s)

GUPTA ET AL.

Examiner

ANNETTE H. PARA

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 17-19, 21 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 17-19, 21, 23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date 08112009
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Art Unit: 1661

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/10/2009 has been entered.

Listing of the Claims

Claims 1-13, 17-19, 21, and 23-26 are examined. Claims 14-16, 20 and 22 have been cancelled.

Claim Rejections - 35 U.S.C. §103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

35 U.S.C. §103(a).

The *Graham* court set forth the factual inquiries that are applied for determining obviousness under 35 U.S.C. 103(a):

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966).

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that

Art Unit: 1661

was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-13, 15-19, 21, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pullman et al. (US 5,294,549 published on March, 15 1994) in view of Gupta (US 5,563,061 1996).

The claims are drawn to a method for producing conifer somatic embryos by cultivating pre-cotyledonary cells in a medium comprising nutrient wherein the osmolality is from 180 mM/Kg to 400 mM/Kg then transferring them to a synchronization medium comprising abscisic acid, gibberellin, maltose as the principal sugar source and activated charcoal as an absorbent for a period of .5 week to 5 weeks. And finally, transferring the pre-cotyledonary somatic embryos to a development medium for a period from 9 to 14 weeks to produce cotyledonary somatic embryos.

Pullman et al teach a method of cultivating conifer pro-cotyledonary somatic embryos in a maintenance medium comprising nutrients that sustain the embryos. The maintenance medium has an osmolality of 170mM/Kg to about 240 mM/Kg (column 15, lines 1-3). The pro-cotyledonary are then transferred to a liquid singulation (synchronization) medium comprising gibberellin and/or abscisic acid at concentrations of 0.05 and 15 mg/L (col. 13, lines 40-60) and comprising also activated charcoal (col. 13, lines 50-54), for at least 3 weeks (col. 15, lines 23-26). This medium has a reduced osmotic level compared to the one of the maintenance medium, thus less than 170 mM/Kg (column 15, lines 13-14). Finally, the pro-cotyledonary embryos are transferred to a development medium wherein the osmolality is above about 400 mM/Kg (col. 15, line 60). Pullman et al. also teach the use of activated charcoal at a concentration of 2.5g/L (Table 2). Further Pullman et al. teach media with a pH of 5.7 (Table 1). Pullman et al. teach that this method can be used for many species including loblolly pine (col. 7, lines 50-60).

Pullman et al. is silent in the time frame period claimed in step (c) and but the amount of time the embryos are kept on the development medium is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an

Art Unit: 1661

artisan of ordinary skill to determine the optimal time the embryos have to be kept on the development medium to best achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of time would have been obvious at the time of Applicant's invention.

Although none of the references teach that the method used produces 50% or 75% of the embryos population at the same developmental stage produced by the instant method, it would be known that by using known media and other well-known medium additives, it would be obvious that one skilled in the art would have obtained 50% or 75% of the embryos population at the same developmental stage.

None of the references teach a solid singulation (synchronization) medium but the use of a solid medium is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of time would have been obvious at the time of Applicant's invention.

Pullman et al. fail to teach a singulation (synchronization) medium comprising maltose as the principal sugar source.

However,

Gupta teaches a singulation medium comprising maltose as the principal sugar source.

At the time the invention was made it would have been obvious for one of ordinary in the art to modify the method of Pullman et al. by using maltose as the principal sugar source in the singulation medium. One of ordinary skill in the art would have been motivated to use maltose as the principal sugar source in the singulation medium knowing that it "results in stronger embryos that, in turn, produce more robust cotyledonary somatic embryos having close similarity to zygotic embryos" (US 5,563,061 column 7, lines 45-55). Thus, the invention as a whole was clearly *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Art Unit: 1661

Comment

No claims are allowable.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette H. Para whose telephone number is (571) 272-0982. The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg, can be reached at (571) 272-0975. The fax number for the organization where the application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Art Unit: 1661

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For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

/Annette H Para/
Primary Examiner